

II. REMARKS

The Examiner rejected claim 15 under 35 U.S.C. §103(a) as being unpatentably obvious over a combination of United States Patent Nos. 5,067,494 (Reinmueller), 5,915,381 (Nord) and 6,436,127 (Anderson). Applicant traverses this rejection of the claim, and asserts that the Examiner has failed to establish the required *prima facie* case of obviousness.

When making a rejection under 35 U.S.C. §103(a), an Examiner has the burden of factually supporting his conclusion of obviousness with a *prima facie* case of obviousness. See generally, MPEP 8th Edition, §2142. If the Examiner does not meet this initial burden, the applicant is under no obligation to submit evidence of nonobviousness. Id.

To establish the required *prima facie* case of obviousness, the Examiner must put forth a rejection that satisfies three criteria. MPEP 8th Edition, §2143. First, there must be a suggestion or motivation to modify the reference or to combine the references in the manner stated by the Examiner. Id. The suggestion or motivation can be found in the references themselves, or in the knowledge of one of ordinary skill in the art. Id. Second, there must be a reasonable expectation of success. Id. Lastly, the reference, or references when a combination is cited, must teach or suggest all limitations of the rejected claim. Id.

In the rejection of claim 15, the Examiner has disregarded express limitations in the claim. Furthermore, the cited combination of references completely lacks any teaching or suggestion of *all limitations* of the claim. As a result, the Examiner has not met his burden of producing a *prima facie* case of obviousness, and the rejection must be withdrawn.

Claim 15 expressly requires an “abort switch adapted to halt the apparatus for administering radiation therapy and open a closed one of the first and second selectively operable valves.” In making his obviousness rejection, the Examiner acknowledges the defect of the combination of Reinmueller and Nord relating to the abort switch, noting that “Reinmueller/Nord fails to specifically teach an abort switch adapted to halt the apparatus and open closed [sic] one of the first and second

selectively operable valves.” April 3, 2003 Office action, page 3. To cure this defect, the Examiner asserts Anderson, noting only that “Anderson teaches an apparatus for delivering radiation therapy with a common abort switch....” *Id.* The Examiner summarily asserts that, because of this simple disclosure of an abort switch in an apparatus for delivering radiation therapy, “...it would have been obvious to one of ordinary skill in the art to modify the apparatus of Reinmueller/Nord to include the about [sic] switch of Anderson et al. to allow termination of radiation therapy if the correct parameters are not optimum....” *Id.*

Applicant respectfully traverses this rejection for at least the reason that the Examiner has completely ignored express limitations of claim 15 requiring that the abort switch is “...adapted to halt the apparatus for administering radiation therapy and open a closed one of the first and second selectively operable valves.” The combination of Reinmueller/Nord/Anderson is completely devoid of any teaching of an abort switch adapted to both halt an apparatus for delivering radiation therapy and open a closed one of a first and second valves. Indeed, careful review of Anderson reveals that the abort switch is only disclosed summarily as a “kill switch” that “immediately closes shutter 36 and terminates delivery of therapeutic doses of radiation to the patient.” Anderson, column 12, lines 3 through 5. The disclosure of Anderson makes no mention of further adapting the “kill switch” to also open a closed valve that is adapted to either control inhalation or exhalation of the patient. Furthermore, the shutter 36 of Anderson, which can be controlled by the kill switch, cannot properly be viewed as a valve adapted to control inhalation and/or exhalation of a patient. Rather, as expressly described by Anderson, the shutter 36 simply controls transmission of radiation to the skin of a patient by positioning “...the screen to block the beams, or pass the beams through one of the apertures.” Anderson, column 11, lines 14 through 16.

Thus, the cited combination of references does not produce the required teaching or suggestion of each and every limitation of claim 15. As a result, the Examiner’s asserted *prima facie* case of obviousness is defective.

Even if the Examiner still believes the kill switch of Anderson can be viewed as the abort switch required by claim 15, the asserted combination of references still fails as a *prima facie* case of obviousness for a lack of motivation or suggestion to combine

the references. Anderson is directed to an apparatus for delivering ultraviolet radiation to discrete areas of a patient's skin. Anderson is completely unrelated to any type of suspension of breathing during radiation therapy (see, for example, Figures 1 and 2). One of ordinary skill in the art would have no technological motivation to look to Anderson for an abort switch adapted to both halt an apparatus for delivering radiation therapy and open a valve adapted to control inhalation and/or exhalation of a patient. As described above, if Anderson were consulted by one of ordinary skill in the art, the reference would not provide the abort switch required by claim 15.

For at least these reasons, the Examiner has failed to establish the required showing of *prima facie* obviousness, and the asserted rejection must be withdrawn.


Applicant respectfully asserts that claim 15 defines patentable subject matter, and requests the prompt issuance of a Notice to that effect.

Applicant believes this Reply to be fully responsive to the Office action mailed on April 3, 2003.

If the Examiner believes that personal communication would advance the prosecution of this application, Applicant respectfully requests that the Examiner contact the attorney at the number listed below.

The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 C.F.R. § 1.16 and any patent application processing fees under 37 C.F.R. § 1.17 associated with this communication or credit any overpayment to Deposit Account No. 23-1925. A duplicate copy of this Reply is enclosed.

Respectfully submitted,



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